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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/838,970 | 04/20/2001 | George Daryl Blankenship | LINCP105US | 1244 |

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| EXAMINER |
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GART, MATTHEW S

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| ART UNIT | PAPER NUMBER |
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3625

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,970

Applicant(s)

BLANKENSHIP ET AL. 

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-57 are currently pending in the instant application and are presently under consideration. Amendment A (Paper No. 10) has been entered.

Declaration Under 37 C.F.R. 1.131

Under certain circumstances an affidavit or declaration may be submitted which attempts to attribute a reference to the applicant. If successful, the reference is no longer applicable as prior art.

In the Instant Application, subject matter is disclosed but not claimed in Spear et al. U.S. Patent No. 6,486,439. George Daryl Blankenship is a common inventor in both the 439' reference and the instant invention.

If subject matter, disclosed but not claimed in a patent application filed jointly by Blankenship and another, is claimed in a later application filed by Blankenship, the joint patent or joint patent application publication is a valid reference available as prior art under 35 U.S.C. 102(a), (e), or (f) unless overcome by affidavit or declaration under 37 CFR 1.131 showing prior invention (see MPEP § 715) or an unequivocal declaration by Blankenship under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent or published application.

In the instant application Blankenship submitted a declaration under 37 CFR 1.131 in lieu of an unequivocal declaration under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent or published application. An uncontradicted "unequivocal statement" from the applicant regarding

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the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship. In re DeBaun, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982).

The declaration submitted under 37 CFR 1.131 is not effective because of the following reason:

It is unclear from the Declaration Under 37 C.F.R. 1.131 submitted 6/03/2004 if the applicant is attempting to show:

- (A) reduction to practice of the invention prior to the effective date of the reference;
or
- (B) conception of the invention prior to the effect date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or
- (C) conception of the invention prior to the effect date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

From section (1) of the Declaration Under 37 C.F.R. 1.131 the attorney notes, "this declaration is submitted to establish conception of the invention described and claimed in the instant application prior to February 28, 2001, which is the effective date of Spear (U.S. Patent 6,486,439) and to establish diligence from at least just prior to

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February 28, 2001 until constructive reduction to practice, April 20, 2001.” Per section (1) of the Declaration the examiner is assuming that the attorney is attempting to fulfill (C) conception of the invention prior to the effect date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

The Examiner notes, a conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. Automatic Weighing Mach. Co. v. Pneumatic Scale Corp., 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909).

The Examiner further notes, where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. Ex parte Hunter, 1889 C.D. 218, 49 O.G. 733 (Comm’r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence. In the Declaration Under 37 C.F.R. 1.131 the Attorney merely alleged that the applicant had been diligent (sections 5, 6 and 7) and presents no evidence to the fact.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Spear, U.S. Patent No. 6,486,439.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Referring to claim 1. Spear discloses a system for managing welding consumables, comprising:

- A welder having a consumable monitor (column 5, lines 27-38); and
- A remote system that interfaces to the welder via a network, the remote system adapted to facilitate management of welding consumables for the welder based at least in part upon information received from the consumables monitor (column 12, lines 32-51).

Referring to claim 2. Spear further discloses a system wherein the remote server is further adapted to facilitate ordering and/or purchasing of a consumable based upon information received from the consumables monitor (column 12, lines 32-51).

Referring to claim 3. Spear further discloses a system wherein the consumable is at least one of wire, gas, flux, contact tip and consumable electrode (abstract and column 1, lines 25-62).

Referring to claim 4. Spear further discloses a system wherein the wire is used for at least arc welding (column 6, lines 29-59).

Referring to claim 5. Spear further discloses a system wherein the consumable electrode is used for at least one of arc gauging and manual shielded arc welding (column 1, lines 25-61).

Referring to claim 6. Spear further discloses a system wherein the ordering/purchasing of the consumable is further based at least in part upon a customer ordering model stored on the remote system (Figure 1).

Referring to claim 7. Spear further discloses a system wherein the order/purchasing of the consumable is further based at least in part upon a vendor managed replenishment contract (Figure 2).

Referring to claim 8. Spear further discloses a system wherein ownership of the consumables remain with a supplier, distributor or manufacturer until the consumables has been used by the customer (column 8, line 47 to column 9, line 7).

Referring to claim 9. Spear further discloses a system wherein the welder is leased to a customer and enforcement of the lease is performed at least in part based upon information received from the consumables monitor (column 6, lines 31-59).

Referring to claim 10. Spear further discloses a system wherein the remote system is further adapted to enforce welding equipment and welding software maintenance, service or upgrade contract, having terms that a maintenance fee is waived or reduced if order and usage requirement of welding consumables is met (column 8, line 43 to column 9, line 7).

Referring to claim 11. Spear further discloses a system wherein a customer is invoiced by the remote system for consumables based at least in part upon information received from the consumables monitor (Figure 4, Figure 5, and Figure 6).

Referring to claim 12. Spear further discloses a system wherein the network employs at least IP (Figure 7).

Referring to claim 13. Spear further discloses a system wherein information exchanged between the welder and the remote system includes at least JAVA (claim 11).

Referring to claim 14. Spear further discloses a system comprising at least a LAN (Figure 1).

Referring to claim 15. Spear further discloses a system wherein the welder interfaces to the remote system via at least a local network (Figure 1).

Referring to claim 16. Spear further discloses a system wherein the welder comprises an arc/weld quality monitor providing information regarding weld quality to the remote system (column 1, lines 25-61).

Referring to claim 17. Spear further discloses a system wherein a customer is invoiced by the remote system for consumables based at least in part upon information regarding weld quality received from the arc/weld quality monitor (Figure 4, Figure 5, and Figure 6).

Referring to claim 18. Spear further discloses a system wherein the remote system tracks patterns of usage of welding consumables and/or welding consumables inventory levels (claim 30 and claim 31).

Referring to claim 19. Spear further discloses a system wherein the remote system facilitates Just-In-Time welding consumables raw material inventory management to achieve low inventory and/or high service level objectives in production (column 8, line 44 to column 9, line 7).

Referring to claim 20. Spear further discloses a system wherein the remote system, at least in part upon information received from the consumables monitor, is adapted to perform enterprise resource planning, production capacity planning and/or welding consumables forecast planning by a welding consumables manufacturer, distributor and/or supplier (column 8, line 44 to column 9, line 7).

Referring to claim 21. Spear discloses a system for managing welding consumables, comprising:

- A welder having a consumable monitor (column 5, lines 27-38); and

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- A local system (claim 2) operatively coupled to the welder via a first network, the local system adapted to facilitate management of welding consumables for the welder based at least in part upon information received from the consumables monitor (column 12, lines 32-51).

Referring to claim 22. Spear further discloses a system comprising a remote system operatively coupled to the local system via a second network, the remote system adapted to facilitate management of welding consumables for the welder (Figure 1).

Referring to claim 23. Spear further discloses a system wherein the second network is at least one of a local network, an extranet and the Internet (Figure 1).

Referring to claim 24. Claim 24 is rejected under the same rationale as set forth above in claim 2.

Referring to claim 25. Claim 25 is rejected under the same rationale as set forth above in claim 3.

Referring to claim 26. Claim 26 is rejected under the same rationale as set forth above in claim 4.

Referring to claim 27. Claim 27 is rejected under the same rationale as set forth above in claim 5.

Referring to claim 28. Claim 28 is rejected under the same rationale as set forth above in claim 6.

Referring to claim 29. Spear further discloses a system wherein the production control system, at least based in part upon information received from the consumables

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monitor, is adapted to perform production capacity planning and/or welding consumables forecast planning (column 8, line 44 to column 9, line 7).

Referring to claim 30. Spear further discloses a system wherein the financial accounting system, at least based in part upon information received from the consumables monitor (column 8, line 44 to column 9, line 7).

Referring to claim 31. Spear further discloses a system wherein the materials management system, at least based in part upon information received from the consumables monitor, is adapted to perform welding consumables inventory management and/or welding consumables procurement (column 8, line 44 to column 9, line 7).

Referring to claim 32. Spear further discloses a system wherein the first network is at least one of a local network, an extranet and the Internet (Figure 1).

Referring to claim 33. Claim 33 is rejected under the same rationale as set forth above in claim 12.

Referring to claim 34. Claim 34 is rejected under the same rationale as set forth above in claim 13.

Referring to claim 35. Spear further discloses a system wherein the welder further comprises an arc/weld quality monitor providing information regarding weld quality to the local system and/or the remote system (column 1, lines 25-61 and column 12, lines 32-51).

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Referring to claim 36. Spear further discloses a system wherein a customer is invoiced by the remote system for consumables based at least in part upon information regarding weld quality received from the arc/weld quality monitor (column 9, lines 8-33).

Referring to claim 37. Spear discloses a system for managing welding consumables, comprising:

- Means for monitoring consumables usage (column 12, lines 32-51);
- Means for determining ordering levels for a consumable (column 2, line 66 to column 3, line 31); and,
- Means for ordering a consumable based at least in part upon the monitoring consumable usage (column 2, line 66 to column 3, line 31).

Referring to claim 38. Spear discloses a system for managing welding consumables, comprising:

- A consumable monitor component adapted to monitor consumable usage and/or consumable status of a welder (column 12, lines 32-51);
- A customer component to facilitate welding resource management based at least in part upon information regarding consumables usage and/or consumable status received from the consumable monitor component (claim 30 and claim 31); and
- A supplier component adapted to receive information from the customer component to facilitate purchasing and/or ordering of welding consumables (claim 30 and claim 31).

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Referring to claim 39. Spear further discloses a system wherein the customer component further comprises a materials management component (column 8, line 43 to column 9, line 7).

Referring to claim 40. Claim 40 is rejected under the same rationale as set forth above in claim 3.

Referring to claim 41. Claim 41 is rejected under the same rationale as set forth above in claim 4.

Referring to claim 42. Claim 42 is rejected under the same rationale as set forth above in claim 5.

Referring to claim 43. Spear discloses a system for managing welding consumables, comprising:

- A consumable monitor for aggregating consumable usage (column 5, lines 27-38 and Figure 2);
- An inventory replenishment component adapted to receive information from the aggregation component (Figure 4, Figure 5, and Figure 6);
- A procurement management component adapted to receive information from the aggregation component and to determine, at least based in part upon inventory data, forecast data and/or information associated with a vendor managed replenishment contact, whether to initiate reordering of the consumables (claim 30 and claim 31);

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- A reorder proposal component for generating a reorder proposal once the procurement management component has initiated reordering of the consumable (claim 30 and claim 31);
- An authorization component adapted to receive authorization for the reorder; and (claim 25),
- A supplier component adapted to receive the consumable reorder to facilitate purchasing and/or ordering of welding consumables (claim 30 and claim 31).

Referring to claim 44. Claim 44 is rejected under the same rationale as set forth above in claim 13.

Referring to claim 45. Spear discloses a method for managing welding consumables, comprising:

- Receiving information regarding consumable usage (claim 16);
- Determining whether supply of a consumable has fallen below ordering threshold (claim 16); and,
- Ordering consumable based at least in part upon information received regarding consumable usage (claim 16).

Referring to claim 46. Claim 46 is rejected under the same rationale as set forth above in claim 43.

Referring to claim 47. Claim 47 is rejected under the same rationale as set forth above in claim 43.

Referring to claim 48. Spear discloses a method for managing consumables comprising:

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- Receiving information regarding consumer usage (column 12, lines 32-51); and,
- Invoicing customer for consumable based at least in part upon information received regarding consumable usage (column 9, lines 8-33).

Referring to claim 49. Spear discloses a method for managing consumables comprising:

- Receiving information regarding consumer usage (column 12, lines 32-51);
- Receiving information regarding weld quality (column 1, lines 25-61); and,
- Invoicing customer for consumable based at least in part upon information received regarding consumable usage (column 9, lines 8-33).

Referring to claim 50. Spear discloses a method for managing consumables comprising:

- Receiving information regarding usage of a consumable (column 12, lines 32-51);
- Obtaining information regarding inventory of the consumable (column 7, lines 26-63);
- Obtaining information regarding a vendor managed replenishment contract (column 7, lines 26-63);
- Determining whether the inventory level of the consumable has fallen below a threshold ordering level (claim 16); and,
- Transmitting a reorder of the consumable (column 7, lines 26-63).

Referring to claim 51. Claim 51 is rejected under the same rationale as set forth above in claim 43.

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Referring to claim 52. Claim 52 is rejected under the same rationale as set forth above in claim 45.

Referring to claim 53. Spear further discloses a system wherein the threshold ordering level is updates continuously and in real-time from aggregated welding consumables data, supplier's lead time for the consumables, availability of the consumables and/or consumable pricing data (column 8, line 43 to column 9, line 7)

Referring to claim 54. Claim 54 is rejected under the same rationale as set forth above in claim 1.

Referring to claim 55-57. Spear further discloses a computer-readable medium having computer0executable instructions for executing at least a portion of the method of claim 45, 48 and 50 (claim 34).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MSG

February 11, 2004



Jeffrey A. Smith
Primary Examiner